REMARKS/ARGUMENTS

Claims 1-25 were presented and examined. The Examiner rejected claims 1-3, 6-10, 14-18, and 22-25 under 35 USC § 103(a), as being unpatentable over U.S. Patent No. 5,899,975 (Nielsen), U.S. Patent No. 5,987,504 (Toga), and U.S. Patent No. 6,023,714 (Hill et al.). Claims 4, 11-13, and 19-21 were rejected under 35 USC § 103(a) as being unpatentable over Nielsen, Toga and Hill, as applied to claim 1 above, and further in view of U.S. Patent No. 6,640,210 (Schaefer et al.). The Examiner rejected claim 5 under 35 USC § 103(a) as being unpatentable over Nielsen, Toga and Hill, as applied to claim 1 above, and further in view of U.S. Patent No. 6,311,215 (Bakshi et al.).

Claim rejections under 35 USC § 103(a)

The Examiner rejected claims 1-3, 6-10, 14-18, and 22-25 under 35 USC § 103(a), as being unpatentable over Nielsen, Toga, and Hill.

In response to the rejection of independent claim 1, Applicant has amended the claim to recite that the system is configured to determine when at least a portion of the information provided by the server is unsuitable for presentation to the user as audio information and to respond to this determination by storing the unsuitable portion of the information for subsequent access by the user. Because claim 1 as amended incorporates limitations previously presented in claim 2 (now canceled), no new matter is introduced by this amendment.

Claim 1 as amended is patentable over the cited references because there is no suggestion or motivation to modify or combine the cited references to arrive at the claimed combination. A Section 103(a) rejection is appropriate only when there is some teaching, suggestion, or motivation combine or modify the teachings of the cited references to produce the claimed invention. MPEP 2143.01.

Claim 1 as originally presented recited a system including a client capable of presenting information received in response to a request as audio information. The system was recited as being configured to determine when a portion of the information presented to the client is not suitable for presentation as audio information. Upon making this determination, the invention as recited in originally presented claim 1, took one of three possible actions, namely, storing the portion not suitable for audio presentation, providing a visually enhanced version of the

information, and providing those portions of the information that are suitable for audio presentation.

Rejecting claim 1 as originally presented, the Examiner acknowledges that Nielsen fails to disclose two of the three responses: storing the information and presenting a visually enhanced version of the information. To support the rejection of claim 1 as originally presented, the Examiner relied on Toga for disclosing a system in which client-request information is stored for later retrieval by the client. Applicant submits that, by incorporating the limitations of claim 2 and further amending claim 1 to limit the claimed invention to the case of storing information found to unsuitable for presentation as audio information, Claim 1 as amended obviates a Section 103(a) rejection based on Nielsen and Toga.

Supporting the rejection of originally presented claim 2, the Examiner indicated that column 8, lines 15-29 of Nielsen disclose that information is unsuitable for presentation to the user as audio information. The cited portion of Nielsen reads as follows:

> When stylesheets in accordance with the invention are downloaded into a computer which is not equipped to provide audio presentations to the user, by voice synthesizer or otherwise, the audio style statements are simply disregarded. This is specifically provided for within the Cascading Stylesheet, Level 1 Recommendation and is a general property of html. When a command is encountered which the system doesn't recognize, it simply ignores it. Thus, the existence of audio style commands in a stylesheet will not adversely affect the style statements for display of text. However, when styles can be set for an audio presentation, those style statements will be recognized and implemented. The result is a much more pleasing and semantically consistent audio presentation for the user.

Thus, Nielsen explicitly teaches that, when requested content is not suitable for audio presentation, the content is discarded. In sharp contrast, claim 1 as amended recites that information not suitable for presentation as audio information is stored for subsequent retrieval. There is no suggestion to modify Nielsen to incorporate the teachings of Toga, because Nielsen explicitly teaches away from taking further action with respect to information not suitable for audio presentation. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Because there is no motivation or

suggestion to combine the cited references to arrive at the combination claimed in amended claim 1, Applicant would respectfully request the Examiner to reconsider and withdraw the Section 103(a) rejection of claim 1 and all claims dependent thereon.

In addition to the foregoing, Applicant has amended claim 8 to recite that a URL is dynamically generated where the URL indicates the location at which the information is stored. This URL is then emailed to the user. The cited references do not disclose or suggest this limitation. In rejecting claim 8 as originally presented, the Examiner acknowledged that none of the cited references teach creating a link indicating where the stored information is located. Instead the Examiner rejected claim 8 by asserting that it is notoriously well known that web sites contain hyperlinks that enable a user to email to the location of a page to any email address.

Applicant would submit that amended claim 8 recites more than the concept of emailing a hyperlink. Specifically, amended claim 8 recites, in conjunction with storing requested information (that is not suitable for audio presentation), dynamically creating a URL indicating where the information is stored and emailing the URL to the requestor. Toga, which is the reference cited by the Examiner to teach the information storage limitation, is explicitly limited to delivering the stored information to the client. See, e.g., Toga Abstract ("the server forwards the requested data file to the E-mail address..."). Thus, a Section 103(a) rejection of the claim 8 as amended based upon the cited references is inappropriate because the cited references do not teach all of the claim limitations. A Section 103(a) rejection is proper only when the cited references teach all claim limitations. MPEP 2143.03. Accordingly, Applicant would respectfully request the Examiner to reconsider and withdraw the Section 103(a) rejection of claim 8 as amended. Analogous arguments apply to claim 22 as amended and its dependent claims.

In response to the rejection of independent claim 10, Applicant has amended the claim to limit the claimed method to one of the three originally presented options for handling requested information not suitable for presentation as audio information. In amended claim 10, the method responds to detecting information not suitable of audio presentation by presenting a visually enhanced version of the requested information.

Claim 10 as amended claim is patentable over the cited references because there is no suggestion or motivation to modify or combine the cited references to arrive at the claimed

combination. A Section 103(a) rejection is appropriate only when there is some teaching, suggestion, or motivation combine or modify the teachings of the cited references to produce the claimed invention. MPEP 2143.01.

Claim 10 as originally presented recited a system including a method for presenting information received in response to a request as audio information. The method included determining when a portion of the information presented to the client is not suitable for presentation as audio information. Upon making this determination, the invention as recited in originally presented claim 10, like claim 1 discussed above, took one of three possible actions, namely, storing the portion not suitable for audio presentation, providing a visually enhanced version of the information, and providing those portions of the information that are suitable for audio presentation.

Rejecting claim 10 as originally presented, the Examiner acknowledges that Nielsen fails to disclose presenting a visually enhanced version of the information. To support the rejection of claim 10 as originally presented, the Examiner relied on Hill for disclosing a system in which a visually enhanced version of client-requested information is presented to a user. Applicant submits that, limiting claim 10 to the case of presenting a visually enhanced version of the information found to unsuitable for presentation as audio information, Claim 10 as amended obviates a Section 103(a) rejection based on Nielsen and Hill.

As argued above with respect to amended independent claim 1, Nielsen explicitly teaches that, when requested content is not suitable for audio presentation, the content is discarded. In contrast, claim 10 as amended recites that information not suitable for presentation as audio information is stored for subsequent retrieval. There is no suggestion to modify Nielsen to incorporate the teachings of Hill, because Nielsen explicitly teaches away from taking further action with respect to information not suitable for audio presentation. Because there is no motivation or suggestion to combine the cited references to arrive at the combination claimed in amended claim 10, Applicant would respectfully request the Examiner to reconsider and withdraw the Section 103(a) rejection of claim 10 and all claims dependent thereon.

In response to the rejection of independent claim 18, Applicant has amended the claim to limit the claimed method to two of the three originally presented options for handling requested information not suitable for presentation as audio information. In amended claim 18, the

program product responds to detecting information not suitable of audio presentation by either storing the information (analogous to the system of amended claim 1) or presenting a visually enhanced version of the requested information (analogous to the method of claim 10).

As argued above with respect to amended independent claims 1 and 10, Nielsen explicitly teaches that, when requested content is not suitable for audio presentation, the content is discarded. In contrast, claim 18 as amended recites that information not suitable for presentation as audio information is either stored for subsequent retrieval or presented in a visually enhanced formation. There is no suggestion to modify Nielsen to incorporate the teachings of Toga or Hill, because Nielsen explicitly teaches away from taking further action with respect to information not suitable for audio presentation. Because there is no motivation or suggestion to modify or combine the cited references to arrive at the combination claimed in amended claim 18, Applicant would respectfully request the Examiner to reconsider and withdraw the Section 103(a) rejection of claim 18 and all claims dependent thereon.

In this response, Applicant has addressed the Examiner's claim rejections under 35 USC § 103(a), which is the only issue in the application. Accordingly, Applicant believes that this response constitutes a complete response to each of the issues raised in the office action. In light of the amendments made herein and the accompanying remarks, Applicant believes that the pending claims are in condition for allowance. Accordingly, Applicant would request the Examiner to withdraw the rejections, allow the pending claims, and advance the application to issue. If the Examiner has any questions, comments, or suggestions, the undersigned attorney would welcome and encourage a telephone conference at 512.428.9872.

Respectfully submitted,

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